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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/462,765	06/02/00	GUTMAN	R 440191/PALL

LEYDIG VOIT & MAYER  
700 THIRTEENTH STREET NW  
SUITE 300  
WASHINGTON DC 20005

IM62/1115

EXAMINER

SAVAGE, M

ART UNIT

PAPER NUMBER

1723

DATE MAILED:

11/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/462,765

Applicant(s)

Gutman et al

Examiner

Matthew Savage

Group Art Unit

1723



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-65 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-65 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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D1: EP-A-0096306; D2: US-A-4101423

**Ad Section IV:**

1. The separate inventions/groups of invention are:
  - A: Claims 1-42 concerning a filter assembly essentially comprising a heat sterilisable plastics housing, a filter element embedded in end caps and water wettable joints between the filter element and the end caps.
  - B: Claims 43-51 concerning a filter assembly comprising a heat sterilisable plastics housing and an integrity testable filter element.
  - C: Claims 52-65 concerning a valve for a filter assembly.
2. The common subject-matter of groups A and B i.e. a filter assembly comprising a heat sterilisable plastics housing comprising a filter element is generally known from e.g. US-A-3939078, US-A-4361483 and US-A-5531848, as already indicated by the International Search Authority on 26.10.98 (Form 206). Since the distinguishing feature(s) of the independent claims of groups A and B are neither the same or equivalent, these claims lack unity a posteriori.
3. None of the features of independent claim 52 in group C is included in either claim 1 (group A) or claim 43 (group B). It follows that no single general inventive concept is present (Rule 13.1 PCT) and as such claim 52 lacks unity a priori.

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**Ad Section V:**

1. Claim 1 differs from D1, which is considered as the closest prior art, the first and second end caps (35,36) form respective water-wettable joints with the filter medium. The problem to be solved concerns the ability of the filter element to be integrity tested. The same solution for the same problem however is addressed in

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D2, wherein a hydrophilic sealing material (joint) is required to seal the hydrophilic membrane to the hydrophobic end cap. It is noted that the same disclosure of D2 is also present on page 11 of D1 itself. Thus, no inventive step can be acknowledged (Art. 33(3) PCT).

2. The additional features of claims 2, 7-9, 13-17, 28 and 29 are also known from D1 (Art. 33(3) PCT).
3. The particular embodiments defined by claims 6, 18, 19 and 22-27 are not derivable from the available art, either alone or in combination. It follows that these claims meet the requirements of Art. 33(3) PCT.

**Ad Section VIII:**

1. In claim 1 it is unclear how said first and second end caps (35,36) form respective water-wettable joints with the filter medium, since said end caps have only been defined as of a plastics material (Art. 6).
2. Throughout the description, only the use of hydrophobic materials for the filter medium has been indicated. No support is available how these materials are rendered water-wettable, to fall within the scope of claim 1 (Art. 6 support).
3. For the present preliminary examination, it is assumed that both the filter element and the end caps are either hydrophilic or hydrophobic, which are made water-wettable by modification (cf. claim 4). Claim 1 should be in this respect appropriately restricted.
4. Independent claim 1 is not in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the prior art (document D1) being placed in a preamble (Rule 6.3(b)(i) PCT) and with the remaining features being included in a characterising part (Rule 6.3(b)(ii) PCT).

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Savage whose telephone number is (703) 308-3854. This examiner can normally be reached from Monday through Friday from 7:00 AM to 3:30 PM.

The fax numbers for this Group are as follows:

(703) 305-3599 for after final amendments;

(703) 305-7718 for regular amendments;

(703) 305-3602 for un-official papers, e.g., proposed claim amendments for discussion during personal or telephone interviews.



**Matthew O. Savage**  
**Primary Examiner**  
**Art Unit 1723**

**M. Savage**  
**November 13, 2000**

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